

a means for creating a smooth waveform display in a digital oscilloscope. The device contained an arithmetic logic circuit to perform a mathematical algorithm and a Read-Only Memory (ROM) to hold the solution. The claims were drafted in a manner that would cover a properly programmed general purpose computer.

The Examiner found that the only unique thing in the claims was that portion that could be performed by a general purpose digital computer, and accordingly rejected the claims as nonstatutory under section 101. The Board of Patent Appeals and Interferences sustained the rejection. The CAFC reversed the Board's decision stating that "a computer operating pursuant to software may represent patentable subject matter, provided, of course, that the claimed subject matter meets all of the requirements of Title 35" and that any idea to the contrary is "without basis in the law." Id. at 35-36.

Alappat directly addresses the Office Action's concern, namely whether these claims are "truly drawn to the specific apparatus distinct from other apparatus capable of performing the identical functions." (quoting In re Walter, 205 USPQ 408, 397). The Office Action in Alappat notes that the claims disclose a general purpose computer, which is "apparently evidence that the invention was really in the process embodied in a computer program rather than in the apparatus" (quoting Ex parte Akamatsu, 22 USPQ 1915), and argues that "[g]eneral purpose computers are

simply tools in performing a business function in the same genre as pencil, paper, handheld calculator, etc."

Alappat teaches that a properly programmed computer is very different from a pencil, and that the difference goes beyond the fact that a pencil is, as the Office Action states, "de-mystified":

[P]rogramming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from programmed software.

Alappat at 35. Claims 1-8 of the present invention all contain a general purpose computer specifically programmed to perform "particular functions", like those in Alappat.

Furthermore, the Office Action cites Ex parte Murray, 9 USPQ2d 1819 (PTO Bd. Pat. App. & Int'f 1988), in support of the proposition that the claims do not fall within the statutory classes set forth in 25 U.S.C. 101. While Murray is informative about what made those particular claims nonstatutory, the Murray court distinguished the claims from those claims that were found to be patentable in Paine, Webber by noting that "the [Paine, Webber] court had before it patent claims directed to a 'system' The patent contained no 'method' claims. Consequently, the court was not presented, as we are here, with a 'method of doing business.'" Id. at 1821. Claims 1-8 of the present amendment are not "method" claims and are therefore more like those before the court in Paine, Webber than those in Murray. The Murray court also acknowledged that while a method of doing

business generated by the system is not patentable, "an apparatus or system capable of performing a business function may comprise patentable subject matter" Id. Accordingly, the cases cited by the Examiner also point to the patentability of the present claims.

The Examiner points to the fact that the claimed computer system performs "functions normally performed by an insurance agent, and thus . . . [is] a method of doing business." The Examiner also distinguishes the present claims from those in Application of Toma, 575 F.2d 872 (C.C.P.A. 1978), Application of Johnson, 502 F.2d 765 (C.C.P.A. 1974), rev'd on other grounds, Dann v. Johnston, 425 U.S. 219 (1976), Application of Phillips, 608 F.2d 879 (C.C.P.A. 1979) and Paine, Webber v. Merrill Lynch, Pierce, 564 F.Supp. 1358, because of "the underlying field of endeavor." This entirely misses the teaching of Toma as described by the court in Paine, Webber: "the product of a computer program is irrelevant, and the focus of analysis should be on the operation of the program on the computer." Id. at 1369. Here the operations are clearly within the ambit of § 101 because the present invention is a computer system for evaluating insurability of an individual, as recited in all claims of the present invention. It is not a method of doing business.

The error in reasoning can be seen by the Examiner's explanation of why Toma is distinguishable. The Examiner states that Toma presents different "facts and circumstances" because

Toma involved a "method of operating a digital computer to translate language." Toma was originally rejected precisely because translating language was considered outside the "technological arts." Toma 575 F.2d at 877. The U.S. Court of Customs and Patent Appeals reversed, stating that "the inquiry must focus on whether the claimed subject matter . . . is statutory, not on whether the product of the claimed subject matter . . . is statutory" Id. at 877. Accordingly, the claims in the present invention would be patentable, because all claims disclose a computer system. The fact that an insurability rating is the product of this system is irrelevant.

For the reasons noted above the rejection under 35 U.S.C. § 101 has been overcome and should be withdrawn.

Claims 1-8 were rejected under 35 U.S.C. § 103 as being unpatentable over DeTore et al., U.S. Patent No. 4,975,840. This rejection is respectfully traversed.

As noted in the response to the previous Office Action, DeTore only discloses a risk evaluation system for life insurance where computer software automatically provides evaluation data for policy classification by relying upon underwriting information, and assigning weights to problem issues to determine risk classification.

DeTore, however, only focuses on evaluating existing medical problems. It cannot take into consideration lifestyle data as recited in claims 1-8 of the present invention.

Furthermore, DeTore only evaluates risks as they pertain to life insurance, but cannot take determinations relevant to health insurance as in the present invention. Likewise, DeTore fails to provide a basis for determining the effect of lifestyle choices on health insurance coverage as shown in the present invention. Finally, DeTore fails to analyze and then provide a user with suggestions for improving his or her health condition as in all the claims of the present invention.

The Examiner even clearly notes that, on page 6 of the Office Action, DeTore fails to recite the information gathered from an individual including the lifestyle of that individual. A medical data result based on the lifestyle of the individual and a system such as the present one is not obvious, as the Examiner incorrectly notes on page 7 of the Office Action.

The present invention is unique because it surveys information pertaining to individuals' lifestyle, health and medical tests. Furthermore, the present invention assigns risk values that represent varying levels of insurance risk, and compares these values with predefined accepted values to not only evaluate the risk, but also to provide suggestions for improving health and decreasing risk. These functions cannot be accomplished by DeTore or the other cited prior art.

Accordingly, claims 1-8 are not obvious in view of DeTore et al. and the rejection under 35 U.S.C. § 103 has been overcome and should be withdrawn.

Acceptance of this application including claims 1-8 is solicited. In the event that the Examiner has any questions pertaining to this Amendment or the related remarks, in particular, or to this application in general, please telephone the undersigned attorney so that prosecution of this application may be expedited.

Respectfully submitted,



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